



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MCKENNA LONG & ALDRIDGE, L.L.P.
c/o Song K. Jung
1900 K. Street, N.W.
Washington DC 20006

COPY MAILED

OCT 25 2005

OFFICE OF PETITIONS

In re Application of
Atlas
Application No. 09/780,713
Filed: February 8, 2001
Attorney Docket No. 9323.053.00-US
For: MULTI-CHANNEL TEMPERATURE
CONTROL SYSTEM FOR SEMICONDUCTOR
PROCESSING FACILITIES

ON PETITION

This is a decision on the petitions under (1) 37 CFR 1.48(a) to correct the inventorship in the above-identified application and (2) 37 CFR 1.183, requesting waiver of 37 CFR 1.48(a)(2), which requires a statement of lack of deceptive intent from the inventor who is to be deleted as a named inventor. The petitions were filed January 4, 2005 and supplemented on September 19, 2005

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) is **GRANTED**.

The petition under 37 CFR 1.48(a) to correct inventorship is **GRANTED**.

An executed declaration in compliance with 37 CFR 1.63 was filed on February 8, 2001. The executed declaration listed a sole inventor – In-Kwon Jeong.

The instant petitions were filed to correct the inventorship by adding Boris Atlas as the sole inventor and deleting In-Kwon Jeong as the sole inventor.

37 CFR 1.48(a) requires: (1) a request to correct the inventorship that sets forth the desired inventorship change (2) a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (4) the fee set forth in 37 CFR 1.17 (i); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Mr. Atlas has provided a statement that the error in not naming him as inventor occurred without deceptive intent and has executed a declaration listing the proper inventive entity.

Mr. Jeong constructively refuses to sign the statement required under 37 CFR 1.48(a)(2). He has received a number of copies of the statement and has spoken to Attorney Anthony Josephson regarding the reasons why he is not an inventor, yet he delays signing the statement.

It is settled that when the question of inventorship between diverse parties is contested, the USPTO will not relax the requirements of 37 CFR 1.48 by way of 37 CFR 1.183. See In re Cooper, 230 USPQ 638, 639 (Comm'r Pat. 1985). However, a review of USPTO assignment records reveals that Mr. Jeong has executed an assignment of all his rights to Oriol Inc. Oriol, Inc., through its authorized Chapter 7 trustee, has acquiesced to deletion of Mr. Jeong as a joint inventor.

Petitioner has shown (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) is granted.

Petitioner has also satisfied the requirements of 37 CFR 1.48(a): Petitioner requested correction of inventorship and set forth the desired inventorship change; the person being added as an inventor provided a statement that the error in inventorship occurred without deceptive intention on his part; petitioner has obtained waiver of the requirement that the person being deleted as an inventor provide a statement that the error in inventorship occurred with deceptive intention on his part; the processing fee has been authorized; and written consent of the Chapter 7 authorized representative of the assignee was submitted.

Petitioner has shown that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and, accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of Boris Atlas and the deletion of In-Kwon Jeong.

Please find enclosed a corrected filing receipt that reflects the corrected inventorship.

Regarding fees, a petition for waiver of the rules under 37 CFR 1.183 is \$400.00. Only \$130.00 was charged. Pursuant to petitioner's authorization, deposit account no. 50-0911 will be charged a \$270.00 fee.

After the mailing of this decision, the application will be forwarded to Technology Center 3700.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.

A handwritten signature in black ink, appearing to read "E. Shirene Willis".

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

enclosure: corrected filing receipt